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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,706	08/31/2001	Terunori Fujita	1155-0222P	9790
2292	7590	02/09/2004	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			PASTERCZYK, JAMES W	
			ART UNIT	PAPER NUMBER
			1755	

DATE MAILED: 02/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/942,706

Applicant(s)

FUJITA ET AL.

eD

Examiner

J. Pasterczyk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/31/01, 11/3/03, 11/25/03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-15 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8/31/01, 11/3/03
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. This Office action is in response to the IDS filed 8/31/01 and 11/3/03 and the response filed 11/25/03 and refers to the first Office action mailed 8/25/03.

2. The terminal disclaimer filed on 11/25/03 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of USP 6,309,997 has been reviewed and is accepted. The terminal disclaimer has been recorded.

3. The abstract of the disclosure is objected to because it is now much narrower than the claims with respect to the metal M in the transition metal compound. Correction is required. See MPEP § 608.01(b).

4. The drawings are objected to because in figures 1 and 2, the coefficient n should be subscripted, and the variable Y should be changed to something else which is not a conventionally-known symbol for an element, particularly one which applicants contemplate for the metal M, here yttrium, which is a group 3 element. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

5. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, although (A) may appear to refer to the compound of formula (I), when viewed in light of the next reagent being selected from the group consisting of three different genres of compound, use of (A) here instead of (I) is incorrect. This error is also found in claims 9-14.

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Similarly, in claim 3, penultimate clause, "(I)" should be -- (I-a) --; in claim 5, penultimate clause, "(I)" should be -- (I-a-1) --. This terminology would appear to contradict applicants' assertion regarding the terminology of claim 1.

6. The examiner further informally notes that in claims 1, 3, 5 and 7, the variable n should be subscripted. Additionally, in claim 3, the last clause fails to further limit claim 1 since the X variable appears to be defined in claim 1 from which this claim depends, unless in each dependent claim X is to be redefined or narrowed in scope; the latter prospect appears to occur in claim 5 as well as other dependent claims. However, in claim 7 X is left undefined, in which case its definition appears to be the same as given in claim 1. In claim 8 it is not clear if the dependency should be to claim 7 instead of claim 5, or "(I-b)" in l. 2 should be -- (I-a-1) --.

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schulz in view of Jacobsen as cited in and for the reasons of record given in the previous Office action.

9. Applicant's arguments filed 11/25/03 have been fully considered but they are not persuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Contrary to applicants' assertion, the Schulz reference clearly discloses that its subject matter is a nickel or cobalt catalyst with an aluminum cocatalyst reading on the present

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invention, the transition metal compounds being divalent. Thus Schulz is not at all vague regarding the transition metal or aluminum components of its catalyst; see p. 2, l. 31-71.

Although these are all bis-ligand compounds wherein the ligand is a chelate having nitrogen and oxygen atoms bound to the transition metal, the present claims are broad enough with their language of "plural X groups . . . may be bonded to each other to form a ring" to read on these compounds, particularly since n need only make the transition metal compound neutral. Hence the only difference between the present claims and the prior art appears to be in the identity of the metal. Jacobsen clearly teaches that the metal in a compound analogous to that of the present claims may be from groups 3-12 (p. 2, l. 28-32), and a reference is not limited to its preferred embodiments; its teachings may be sufficient to support an obviousness rejection. Furthermore, Jacobsen teaches at p. 5, l. 2-3, and p. 30, l. 29, ligands which read on those of the present invention as now broadly claimed, these ligands being bonded to metals also reading on the present claims. Hence all the elements of the present invention are found within the four corners of the two references.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Pasterczyk whose telephone number is 571-272-1375. The examiner can normally be reached on M-F from 9 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached at 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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